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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,107	10/20/1999	RANDALL S MARSHALL		5105

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EXAMINER

LAYNO, BENJAMIN

ART UNIT PAPER NUMBER

3711

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

**Office Action Summary**

Application No.

09/422,107

Applicant(s)

MARSHALL, RANDALL S

Examiner

Benjamin H. Layno

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 2/20/03 and 3/17/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This response is in reply to the withdrawal of abandonment on 03/17/04. There has been no amendment filed in response to the Examiner's Office action mailed 06/30/03. Therefore, the Examiner is repeating the Office action of 06/30/03 that was in response to the Applicant's last amendment filed on 02/20/03.

### *Specification*

2. The substitute specification filed 1/17/02 has **not** been entered because it does not conform to 37 CFR 1.125(b) because: it does not include a statement that the substitute specification includes **no new matter**, and it does not include a marked up version of the substitute specification showing all the changes (including the matter being added to and the matter being deleted from) to the original specification of record filed 10/20/99.

3. The substitute specification filed 1/17/02 is also objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that **no amendment shall introduce new matter into the disclosure of the invention**. The added material which is not supported by the original disclosure (original specification filed 10/20/99) is as follows:

On page 9, lines 1-4, of the substitute specification, the recitation "As a chart, the top or space 'A' is used for game date and interval number of a module based on a specific number of previous games; space 'B' is used for placing numbers as drawn; space 'C' is used for placing notes by the player; and, space 'D' is used for placing the

number of correct numbers (digits) selected by the player” **introduces new matter** which was not described or suggested in the original specification filed 10/20/99.

Statements referring to spaces “A”, “B”, “C” and “D” are also recited on page 9, lines 10-14; page 10, lines 11-14; page 10, lines 16-20; page 10 line 23 to page 11, line 3; page 11, lines 6-9; page 11, lines 12-15; page 11, lines 18-21; page 11, line 24 to page 12, line 5.

4. To correct the specification, the Applicant is required to provide: (1) another substitute specification which **does not include new matter**, (2) a statement, on a sheet separate from the substitute specification, that the substitute specification includes **no new matter**, (3) a marked up version of the substitute specification showing all the changes (including the text or words being added to, and the text or words being deleted from) to the original specification of record filed 10/20/99.

### ***Drawings***

5. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 1/17/02 have been disapproved because they **introduce new matter into the drawings**. 37 CFR 1.121(f) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure filed 10/20/99 does not support the showing of spaces “A”, “B”, “C” and “D”.

6. The proposed drawing correction filed on 1/17/02 has been disapproved because it is not in the form of a pen-and-ink sketch showing changes in red ink or with the changes otherwise highlighted. See MPEP § 608.02(v).

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7. To correct the drawings, the Applicant must provide new substitute sheets of drawings that do not include the new matter (spaces "A", "B", "C" and "D"). If the new substitute sheets of drawings are submitted and include proposed changes to the original drawings filed 10/20/99, the proposed changes must be shown in red ink.

***35 USC 112 1<sup>st</sup> Paragraph Rejection***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

9. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 14-16, 18, 20, 21 and 24-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite "a play slip and play slip chart". The substitute specification and drawing filed 1/17/02 do not clearly define the difference between the "play slip" and "play slip chart". Figs 1-9 do not clearly illustrate the difference between the "play slip" and "play slip chart". Are the "play slip" and "play slip chart" two separate elements? The Examiner is confused. Correction is required.

Claims 15, 16, 22 and 24-35 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 15, 16, 22 recite "**adjustable** landmark lines". There is no recitation in the specification which describes "**adjustable** landmark lines". How are the landmark lines adjustable? Can they be erased and redrawn on the play slip?

### ***35 USC 112 2nd Paragraph Rejection***

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 13-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 13-23 recite the limitation "**numbers** of said play slip and play slip chart over a specific number of **previous games**" near the end of each claim. There is no positive recitation of "previous games" in the preamble or beginning of claims 13-23. Also there is no positive recitation of "**numbers**" which are used in "previous games" in the preamble of claims 13-23. Thus, there is insufficient antecedent basis for these limitations in the claims. Claims 13-23 must have a more specific description of the game where the "betting system" is used. Correction is required.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 13-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Doctor Gray's Grid.

Doctor Gray's Grid discloses a betting system used in the charting of winning lottery numbers selected in the Ohio 3-Digit Lottery. The betting system includes a elongated play slip and play slip chart labeled "Doctor Gray's Grid" in the bottom center of the play slip. "Doctor Gray's Grid" shows a of history of the winning lottery numbers selected in all the previous games of the Ohio 3-Digit Lottery from December 1979 through June 1988, see the chart listing the 3-digit winning numbers from December 1979 through June 1988.

The play slip includes at least one board containing a plurality of numbers, see numbers "00" to "99" and numbers "0" to "9". The numbers are divided into a plurality of groups of numbers or positions wherein the numbers "00" to "99" are grouped into column positions on the grid, and the numbers "0" to "9" are grouped into row positions on the grid. The numbers are further divided into groups of numbers or zones marked with landmark lines. Vertical landmark lines define the 100 columns labeled "00" to "99", and the horizontal landmark lines define the 10 rows labeled "0" to "9". The intersection of a column and a row define a square zone. Each square zone represents

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a 3-digit lottery number. For example the square zone on the top left hand corner of the grid represents the 3-digit number "000", while the square zone on the bottom right hand of the grid represents the 3-digit lottery number "999". Each square zone is further divided into a smaller grid of 16 individual small boxes. The number of boxes that have been shaded or colored indicate how many times a 3-digit lottery number has been selected as a winning 3-digit lottery number. For example, in the square zone in row "8", column "04", nine small boxes have been shaded or colored, indicating that the 3-digit number "804" has been selected nine times as the winning 3-digit lottery number in previous games. Whereas, in the square zone in row "5", column "10", no small boxes have been shaded or colored indicating that the 3-digit number "510" was never selected in previous games. Thus, a group of 3-digit numbers with well-shaded square zones indicates "active zones", and a group of 3-digit numbers with less-shaded or non-shaded square zones indicates "inactive zones".

In regard to claims 26 and 28, the only difference between the numbers on Doctor Gray's Grid and the alphabets used in the claimed invention resides in the meaning and information conveyed by printed matter. Such differences are considered unpatentable, *Ex parte Breslow*, 192 USPQ 431.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scarne's Complete Guide to Gambling recites a betting system in the game of roulette wherein players are given a chart with roulette numbers printed thereon, and players keep track of the winning numbers of previous games by checking off the winning numbers on their chart. The patents to Jarvis and Goldfarb disclose



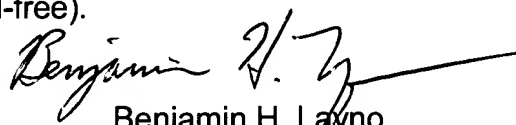
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betting systems wherein players are given lottery or bingo bet slips, and the players keep track of the winning numbers of previous games by checking off the winning numbers on their chart.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on (571)272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl